

REMARKS/ARGUMENTS

Claims 1 to 9 remain in the current application.

Claims 1 to 7 and 9 have been rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,936,668 to Sawanobori et al. ('668) in view of US Patent No. 6,512,607 to Windsor et al. ('607). Applicant respectfully disagrees with the Examiner's assessment. Claim 1 is directed at a method and apparatus for indicating an event change in a liquid crystal display (LCD) and includes the subject matter of determining an event change from a list of event changes and then indicating this event change to a user.

The Office Action from which appeal was taken was issued following the United States Supreme Court's decision in the case of KSR Int'l Co. v. Teleflex Inc., No. 04-1350 (April 30, 2007). In light of the KSR decision, Applicant wishes to address various issues pertaining to a proper analysis under section 103.

The Examiner, by citing references and asserting a reason for combining elements from the references, has elected to base rejection upon a teaching, suggestion or motivation to select and combine features from the cited references. Applicant wishes to point out that the Supreme Court's KSR decision did not reject use of a "teaching, suggestion or motivation" analysis as part of an obviousness analysis, characterizing the analysis as "a helpful insight." KSR slip op. at 14-15.

When the Examiner chooses to base a rejection upon a teaching, suggestion or motivation analysis, the Examiner must satisfy the requirements of such an analysis. In particular, the Examiner must demonstrate with evidence and reasoned argument that there was a teaching, suggestion or motivation to select and combine features from the cited references. E.g., In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). Moreover, the prior art must suggest the desirability of the combination, not merely the feasibility. In re Fulton, 73 USPQ2d 1141, 1145 (Fed. Cir. 2004). Because of the Examiner's chosen ground for rejection, however, the only pending ground for rejection must be a "teaching, suggestion or motivation" analysis. In the event that the Examiner chooses to consider a different avenue for rejection, this would be a new ground for rejection not due to any action by Applicant. Applicant has a right to be heard on any new ground for rejection.

Applicant further respectfully reminds the Examiner that, even after KSR, the following legal principles are still valid, having been endorsed by the Supreme Court or having been unaffected by its decision: (1) the USPTO still has the burden of proof on the issue of

obviousness; (2) the USPTO must base its decision upon evidence, and it must support its decision with articulated reasoning (slip op. at 14); (3) merely demonstrating that all elements of the claimed invention exist in the prior art is not sufficient to support a determination of obviousness (slip op. at 14-15); (4) hindsight has no place in an obviousness analysis (slip op. at 17); and (5) Applicant is entitled to a careful, thorough, professional examination of the claims (slip op. at 7, 23, in which the Supreme Court remarked that a poor examination reflected poorly upon the USPTO).

In light of these legal standards, the Examiner has failed to satisfy his burden of proof under section 103. The '668 reference is directed at a method of displaying an image on a display screen. While an image is displayed in a first area of the display screen, a second area of the display screen displays information. However, the information that is being displayed by the second area is static information associated with the image being displayed in the first area. As described in column 7, lines 10 to 18, four images are displayed within the display along with information related to each of the images. This static information includes the date of photographing, an indication of whether a strobe is used, the number of used frames or a remaining amount of a battery (column 5 lines 1 to 3). When displaying the images, the device typically retrieves the image along with information that is stored in device. As the static information regarding an image does not change, there is no need for the device to continuously determine if a new event change has occurred. Furthermore, with respect to information relating to the battery or the number of used frames, this information is constantly stored in the device and therefore there is no requirement to "determine an event change from a list of event changes" since this information is always retrieved and is a constant with respect to the display area. Therefore, Applicant respectfully submits that there is no discussion or suggestion in the '668 reference of the device determining an event change from a list of event changes based on a set of control information and then determining a first drive signal for the determined event change.

With respect to the '607 reference, Applicant respectfully submits that this reference does not suggest, disclose, anticipate or obviate the subject matter of determining an event change and indicating the event change on the display area. The '607 reference provides a description of a display overlay whereby permanent images or wording are printed on the display overlay. Applicant respectfully submits that there is a lack of reason for combining the two references to arrive at the subject matter of the claims and that even if the references are combined, this combination would not render the claims obvious.

Applicant respectfully submits that since there is a claimed element that is not disclosed in either '668 or '607 by the Examiner's evidence, the Examiner's prima facie case of obviousness has not been proven. No matter how much impetus there might be to combine elements from disparate references, one having ordinary skill in the art could not combine the elements from the cited references and come up with what the Applicant recites in the claim.

With respect to Examiner's rejection of Claim 3, when rejecting claims based on inherency, the standard involves not just possibility, desirability or efficiency but must also demonstrate necessity. Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitation, it anticipates. MEHL/Biophile Int'l Corp. v. Milgraum, 192 F.3d 1362, 1365, 52 USPQ2d 1303, 1305 (Fed. Cir. 1999), quoted in In re Cruciferous Sprout Litigation, 64 USPQ2d 1202, 1206 (Fed. Cir. 2002). Applicant respectfully submits that there is no necessity in this situation as the control information can be provided via a hard-wired connection and therefore, the Examiner's rejection of Claim 3 based on inherency is incorrect. For the reasons set forth above, retraction of Examiner's rejection of Claims 1 to 7 and 9 is respectfully requested.

Claim 8 has been rejected under 35 U.S.C. 103(a) as being unpatentable over the '668 reference in view of the '607 reference and further in view of US Patent No. 5,486,914 to Denove et al. ('914). The '914 reference is directed at a device having a backlight indicator but does not include any suggestion or disclosure of the subject matter of determining an event change and indicating the event change on the display area. Retraction of Examiner's rejection of Claim 8 is respectfully requested.

Applicant respectfully submits that the application is now in a position for a Notice of Allowance which Applicant respectfully requests.

Respectfully submitted,
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